

### **REMARKS/ARGUMENTS**

Claims 1 – 11 have been rejected under the judicially created doctrine of nonstatutory double patenting as being unpatentable over Claims 17 – 19 of copending Application No. 10/388,059, now U.S. Patent No. 6,902,699. In response, Applicants have enclosed a terminal disclaimer. Accordingly, Applicants respectfully submit that the double patenting rejection has been overcome.

Claims 1 – 11 have also been rejected under 35 U.S.C. § 103(a) as being obvious in view of U.S. Patent No. 4,818,481 to Luton et al. Luton describes a cryomilled aluminum alloy that is dispersion strengthened by cryomilling the aluminum alloy in the presence of liquid nitrogen and oxygen to form oxy-nitride particles in the alloy. Luton further states that the total amount of oxy-nitrides present in the aluminum matrix will be at least about 10%. See column 6, lines 34-38.

In order to establish a *prima facie* case of obviousness, the reference(s) must teach or suggest all the claim limitations. The Office has failed to establish a *prima facie* case of obviousness because Luton does not teach or suggest each and every claim limitation. Therefore the rejections should be withdrawn.

In contrast to Luton, the claimed invention is directed to an aluminum alloy that is substantially free of refractory materials. Applicants have discovered that refractory materials, such as oxy-nitrides, are undesirable in the aluminum alloy and that aluminum alloys that are substantially free of such materials have improved properties. See page 10 of the present specification. Luton fails to teach or suggest an aluminum alloy that is substantially free of refractory compounds. In fact, Luton actually teaches an aluminum alloy comprising at least 10% oxy-nitride. Thus, Claim 1 and any claims dependent thereon are patentable over the cited reference.

Independent Claim 11 is directed to an aluminum alloy and includes the transitional language “consisting essentially of”. It is well established that the language “consisting essentially of” excludes any additional materials that would have a material effect on the novel properties of the invention. Here, the novel properties of the invention (e.g., high strength) are

obtained by providing an aluminum alloy that is substantially free of refractory materials. Thus, the language consisting essentially of excludes the inclusion of oxy-nitrides because such refractory materials would have a material affect the aluminum alloy. Thus, Luton also fails to disclose or suggest the aluminum alloy recited in Claim 11. Therefore Claim 11 and any claims dependent thereon are also patentable over the cited reference.

In view of the foregoing remarks, it is respectfully submitted that the rejections under 35 U.S.C. § 103(a) as being obvious have been overcome.

#### **Consideration Of Previously Submitted Information Disclosure Statement**

It is noted that an initialed copy of the PTO Form 1449 that was submitted with Applicants' Information Disclosure Statement filed February 5, 2004 has not been returned to Applicants' representative with the Office Action. Accordingly, it is requested that an initialed copy of the Form 1449 be forwarded to the undersigned with the next communication from the PTO. In order to facilitate review of the references by the Examiner, a copy of the Information Disclosure Statement and the Form 1449 are attached hereto. Copies of the cited references were provided at the time of filling the original Information Disclosure Statement, and, therefore, no additional copies of the references are submitted herewith. Applicants will be pleased to provide additional copies of the references upon the Examiner's request if it proves difficult to locate the original references.

#### **Conclusion**

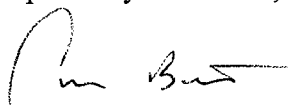
It is respectfully submitted that all pending Claims 1-11 are in condition for immediate allowance and an early notification of the allowability of these claims is earnestly solicited. If any matters remain to be resolved, the Examiner is urged to contact the undersigned attorney by telephone at 704-444-1185 to expedite prosecution of this application.

It is not believed that extensions of time or fees for net addition of claims are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 CFR § 1.136(a), and any fee required

Appl. No.: 10/772,690  
Amdt. dated 05/03/2006  
Reply to Office action of 2/03/2006

therefore (including fees for net addition of claims) is hereby authorized to be charged to Deposit Account No. 16-0605.

Respectfully submitted,



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May 3, 2006

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**CLT01/4791164v1**

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